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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. patent application of SOUTHERN et al.

Serial No. 10/034,446

Examiner: Dennis Dorsey

Filed: December 26, 2001

Art Unit: 3637

For: METHODS FOR ATTACHING SOLID HARDWOOD FLOOR
PLANKS TO CONCRETE FLOOR SURFACES

Office Action mailed: January 6, 2004

Commissioner of Patents
Box 1450
Alexandria, VA 22313-1450

DECLARATION OF JOSEPH J. GRADY, JR.

I, Joseph J. Grady, declare that:

1. I am an expert in the flooring, construction complaint analysis of flooring and flooring substrates, and flooring products that include, but are not limited to, wood parquet and plank flooring, moisture-related flooring problems and substrate testing, and in flooring failures. Attached hereto as Exhibit 1, and incorporated by this reference, is my curriculum vitae, setting forth my training and experience.
2. I have read the captioned patent application and the pending claims, attached hereto as Exhibit 2, the PTO's Office Action in the above-identified application mailed January 6, 2004 (copy attached hereto as Exhibit 3), and the following cited references: Greenway U.S.P. 2,088,238 ("the '238 patent"); Searer U.S.P. 5,570,554 ("the '554

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patent"); and Anderson U.S.P. 3,616,117 ("the '117 patent").

Respectfully, I disagree that these references, taken together, make obvious the subject matter of the pending claims in this application.

3. The '238 patent, applied for in June 1935 and issued in July 1937, discloses attaching wood flooring to raw concrete surfaces using "mastic" alone, without nails. In the 1930's, the only mastics commonly used in the United States for attaching wood flooring of the kind disclosed in the '238 patent to any surfaces were asphalt-based. The use of such mastics for attaching hardwood plank flooring to concrete surfaces would have failed, meaning that the floor would cup, buckle and otherwise distort over time, in part because these mastics were water-permeable. Even if Greenway had disclosed the use of nails with his product, his product would still have failed, because the mastics available in the 1930's and since then, would have failed. To my knowledge, no successful installations of solid wood plank flooring, where the planks were over three feet in length, took place in the United States at any time until the captioned application brought to the marketplace a successful product for direct attachment to concrete.
4. The flooring disclosed in the '554 patent for attachment directly to concrete, would also have failed because moisture/vapor from the concrete surfaces would have penetrated the wood and caused it to warp, bend and cup. Because the '554 patent teaches that nailing alone would lead to a satisfactory result, the '554 patent leads away from the subject matter of the claims in the pending application. I gather that the PTO concedes that the '554 patent teaches no need to use adhesives to attach solid plank flooring to concrete surfaces under any circumstances.

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5. The '117 patent does not disclose anything about attaching solid wood flooring planks to concrete surfaces. The '117 patent does not disclose solid floor planking at all, but rather plywood panels coated on one side with cold-setting glue, an adhesive not within the claims of the above-identified application. Moreover, the adhesives referred to in the claims of the above-identified application are not applied to the wood planks.

I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any registration issued thereon, or any patent to which this verified statement is directed.

This declaration was executed subject to the penalties for perjury under the laws of the State of California, at Los Angeles, California, on _____, 2004.

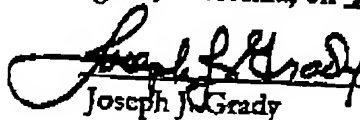
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5. The '117 patent does not disclose anything about attaching solid wood flooring planks to concrete surfaces. The '117 patent does not disclose solid floor planking at all, but rather plywood panels coated on one side with cold-setting glue, an adhesive not within the claims of the above-identified application. Moreover, the adhesives referred to in the claims of the above-identified application are not applied to the wood planks.

I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful and false statements may jeopardize the validity of the application or any registration issued thereon, or any patent to which this verified statement is directed.

This declaration was executed subject to the penalties for perjury under the laws of the State of California, at Los Angeles, California, on 1/23, 2004.


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Inventor 21 2004

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JOSEPH J. GRADY, JR.

Flooring Consultant

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Phone 714-992-0549 Fax #714-992-2458

PROFESSIONAL EXPERIENCE

Extensive experience in construction complaint analysis of flooring substrates, and flooring products that include carpet, vinyl, wood parquet and plank, rubber tile, ceramic tile, and natural stone. Specializing in moisture related flooring problems and substrate testing. Also specializing in floor bonding failures. Over 35 years experience in floor related matters with participation in mediations, depositions, arbitrations, and jury trials.

1994 TO PRESENT

Partner in Advanced Testing Services providing consulting, expert witness, and investigation services for the flooring industry.

THE W W HENRY COMPANY

1973 - 1994

A subsidiary of Armstrong World Industries, manufactures adhesive products for bonding ceiling tiles, wall panels, subfloors, carpet, vinyl and vct, wood, ceramic tile, natural stone and underlayment materials.

DISTRICT MANAGER:

Responsible for sales, complaint handling and analysis, and product field testing.

NATIONAL PRODUCT MANAGER:

Responsible for idea generation, research, and development of new construction adhesives and revisions of existing adhesives. In this position I interfaced with R & D, manufacturing and marketing.

Served as Chairman of the Product Committee:

Duties:

- Prepare product information kits
- Train company and customer reps in adhesive technology
- Establish in-house installation programs
- Conduct installation clinics nationally
- Review, analyze, and inspect job complaints nationally
- Maintain conformity to existing laws in regards to safety, hazards and environmental concerns

NATIONAL MARKET DEVELOPMENT MANAGER:

Provided market research for determining new market opportunities and provided leadership in the development of new adhesives for entry into these markets.

TEACHING ASSIGNMENTS 1993 - 1999

- Guest instructor, Academy of Textiles and Resilient Flooring - Resilient inspectors class.
- Guest instructor, Ceramic Tile Institute of America - "New Products".
- Guest Instructor, Academy of Textiles and Resilient Flooring - Carpet inspector class.
- Guest instructor, Ceramic Tile Institute of America consultant class - "Slip Resistant Floors".
- Guest instructor, Ceramic Tile Institute of America (2 sessions) "Moisture Problems", Slip Fall Problems and Litigation.

SPEAKING ASSIGNMENTS, FLOOR COVERING ASSOCIATIONS: (Partial list)

- Baltimore - Washington
- Philadelphia, Pennsylvania
- Cleveland, Ohio
- Chicago, Illinois
- San Jose, California
- Orange County, California
- Phoenix, Arizona
- San Diego, California
- Seattle, Washington
- Portland, Oregon
- Vancouver, B.C.
- Honolulu, Hawaii
- New York, New York
- Miami, Florida
- New Orleans, La

Joe is past chairman of the Coefficient of Friction Sub Committee of CTIOA.

Joe is also a member of the editorial staff of Business News Publications as a featured columnist.

Published articles, written by Joe Grady, have appeared in trade publications such as Walls and Ceilings, Floor Covering Weekly, Tile Letter, Southwest Floor Covering, Installation, Cleaning & Maintenance News, Tile Industry News, Western Floors, Floor Covering Installer, Tile & Design, and National Floor Trends.

In 1993 Joe was honored as "Tile Professional of the Year" by the Western States Ceramic Tile Association.

In 1997 Joe was presented with the Silver Award by the Ceramic Tile Institute of America.

Joe is currently a partner in Diversified Resources Inc., a manufacturing rep firm providing various flooring membranes and specialty adhesives for the installation of flooring. He is also active in Advanced Testing Services, a branch of DRI, providing testing, consulting and inspection services.

EDUCATION:

Banks Business College: Majored in Business Administration
NOFMA Wood School, Memphis, Tenn.

C.R.I. Carpet School, Dalton, Ga.

PROFESSIONAL ASSOCIATIONS: CURRENT & PREVIOUS

- Co-Chair CTIOA Concrete Sub Committee
- Material & Methods Standards Association (MMSA)
- Tile Council of America (TCA)
- ANSI A-108 Committee (ANSI) - Chairman ANSI A-136.1
- Tile Contractor's Association of America (TCCA)
- National Tile Contractors Association (NTCA), Director
- Associated Tile Contractors (ATC)
- Ceramic Tile Institute of America (CTIOA)
- ASTM F-13 committee
- ASTM F-6 committee
- ASTM C-21 committee
- Orange County Floor Covering Association
- Western States Ceramic Tile Association
- Member of Forensic Consultants Association

PRESENTATIONS:

Western Floor Covering Association: Panel member presenting the first WFCA moisture guidelines.

International Tile & Stone Expo (IT&SE): Panel moderator presenting a program on the ADA and slip resistant flooring.

International Tile & Stone Expo (IT&SE): Presenting "Floor Prep"
Tile West Convention 1996

National Tile Contractors Association (NTCA): Presentation on "Adhesives"

National Wood Flooring Association (NWFA): Presentation on "Moisture"

Tile Contractors Association of America (TCCA): Presentation on "Slip-Falls"

Hacker Industries Inc: National Convention of light weight concrete contractors (Long Beach) presenting "Flooring Problems".

Hacker Industries Inc.: National Convention of light weight concrete contractors (San Antonio) presenting "Standard of Care"

Maxxon Corp., National Convention, Phoenix, Az. - "Flooring Problems"

Associated Tile Contractors (ATC): Presenting "ADA and legal ramifications"

Coverings '98: Moisture Problems seminar

Concrete Tile Manufacturers (CTMA): "Concerns with concrete substrate"

Surfaces Convention 2001, "Flooring Problems"

Surfaces Convention 2003, "Mold & Related Problems"

Converings Convention 2003, "Mold & Related Problems"

PARTIAL LIST OF INSPECTIONS, CONSULTATIONS, DEPOSITIONS, AND TRIALS SINCE 1994:

U.S. Custom House, Long Beach, California

Mercy Hospital, Oxnard

Tracy Ca. Prison

UCI, Dormitory's

San Bernadino Medical Center, (Arrowhead)

Palm Valley Country Club (2000 houses)

Class action law suits over 3000 homes in 10 years

Represented over 20 law firms in this period